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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

WILLIAM P. APPS

Serial No.: 09/891,948

Filed: June 25, 2001

For: STACKABLE LOW DEPTH TRAY

Attorney Docket No.: RPC 0555 PUS

Group Art Unit: 3727

Examiner: S. Castellano

APPELLANT'S REPLY

Mail Stop Appeal Brief - Patents
Commissioner for Patents
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Examiner's Answer mailed February 2, 2006.

(4) SUPPLEMENTAL ARGUMENT

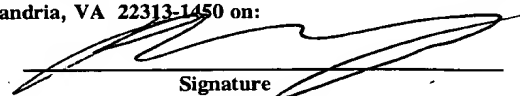
The Examiner originally filed an Examiner's Answer on February 8, 2006. In Appellant's Reply filed April 8, 2005, Applicant pointed out that it filed with its Appeal Brief an "Amendment With Appeal" as provided for in M.P.E.P. §1207 in order to correct minor errors introduced in Claims 1 and 36 in the amendment dated May 27, 2003. The Examiner had taken no formal action on the Amendment With Appeal. However, prior to the Examiner's Brief, the Examiner called Appellant's agent and orally informed her that the Amendment With Appeal would not be entered. The failure to enter the Amendment With Appeal should not substantively affect any issues on appeal.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, U.S. Patent & Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 on:

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The Board, in its Order of July 15, 2005, directed the Examiner to consider the Amendment With Appeal. The Examiner has formally indicated in an Advisory Action that the Amendment With Appeal will not be entered and issued a revised Examiner's Answer referencing this decision. Applicant's review of the revised Examiner's Answer mailed February 2, 2006 shows no other changes from the earlier Examiner's Answer. Since as previously stated, the failure to enter the Amendment With Appeal should not substantively affect any issues on appeal, Applicant files this Appellant's Reply which corresponds to the Appellant's Reply filed April 8, 2005

(11) ARGUMENT

**A. Rejection of Claims 1-36 Under 35 U.S.C.
§ 103(a) Over Apps et al. '279 In View Of
Hammett et al., McGrath And Sauey**

In Appellant's Brief, Appellant argued three main points: (1) There is no motivation or suggestion to combine the cited references; (2) the cited references fail to recognize the problem or solution achieved by the claimed invention; and (3) argument regarding an additional limitation of dependent Claim 32.

The Examiner never addresses the third argument and fails to overcome the rationale of the remaining two points. More importantly, he fails to establish a *prima facie* case of obviousness.

**(1) There Is No Motivation Or Suggestion
To Combine The Said References**

Although this issue is clearly directed towards motivation, the Examiner never attempts to provide such motivation. The whole basis of the Examiner's argument appears to be statements that "Hammett and Sauey teach that the interior columns are lower in height than both the side walls and end walls. McGrath teaches the interior columns are shorter in height than one pair of walls." (Examiner's Brief, page 6.) While these statements are incorrect, the

reasons for which will be pointed out below, the Examiner comes up with no motivation or suggestion from the prior art for a combination of these secondary references with the primary reference. Thus, the Examiner's combination rejection fails for the lack of motivation in the prior art to make the combination.

Further, Hammett does not teach "interior columns" which are lower in height than both the side walls as alleged by the Examiner. Hammett discloses a can tray with neither columns nor any interior walls, as more fully explained in the Appeal Brief. Hammett merely shows "spacers" that are not of sufficient height to provide lateral support to beverage cans, which are the subject matter of the Hammett crate, let alone bottles. The spacers have none of the characteristics of the "columns" limitation as set forth in the claims nor specification. Hammett does not refer to the spacers as columns nor would the spacers be understood as such to one skilled in the art. The labeling of the spacer elements of Hammett as "columns" is mere hindsight by the Examiner and is unsupported by the prior art.

Similarly, Sauey does not teach interior columns of the type called for. While Sauey fails to be a proper secondary reference for many reasons set forth in the Appeal Brief, a primary reason is that Sauey is non-analogous art. Sauey is directed towards a box for packing shotgun shells. The Examiner states "Shotgun shells are carefully packaged *fragile* articles. *Bottles are fragile*. The shotgun shell package or box is very similar with a surrounding wall structure, dividers and interior columns to provide separate pockets for each shell packaged. Support of the shells so that they do not move is of extreme importance. The field of endeavor is the same packaging of *fragile* articles." (Examiner's Brief, page 8, emphasis added.) However, the bottles to be transported are *not* fragile. This is explained in the application:

In general, bottles go through a bottling facility and to the bottler's warehouse in the following order: the bottles are filled, sealed, loaded into trays, and then layers of trays are placed on pallets. Trays in successive layers are stacked or cross-stacked on top of each other, with the bottles bearing most of the load of above-stacked trays. [p. 1, lls. 18-21.]

The Board is also aware from its own handling of soft drink bottles that they are subjected to significant abuse by consumers and are anything but fragile. To suggest, as the Examiner does without any support, that soft drink bottles are “fragile” and comparable to shotgun shells is untenable.

The final secondary reference is McGrath. With McGrath, the Examiner knowingly ignores the limitation of the claims, without informing the Board of his attempt to do so. Appellant claims a bottle case with a plurality of bottle-retaining pockets with interior walls and an interior column member which is of lesser height than the side walls (Group A: independent claims 1 and 36) or side wall pylons (Group B: independent claims 20, 34, and 35). McGrath does not teach any of these limitations. Yet, as stated by the Examiner from Page 6 of his Brief, “McGrath teaches that the interior columns are shorter in height than *one pair* of [end] walls.” (Emphasis and insertion added.) The Examiner believes that partition 46 shown in Figures 25 and 27 of McGrath constitutes a column. If one assumes this to be true, McGrath merely discloses that the height of the handle *in the end walls* may be slightly higher than the partition of McGrath. This is not because of any relationship to Appellant's invention but merely because in the course of creating handles in the end walls, they may be slightly raised. The relationship between the partition height and the *end wall* handle does not in any way teach or suggest Appellant's invention with its requirement that the columns should be of lesser height than *the side walls* or *side wall pylons*. Where, prior to Appellant's disclosure, the columns were the same height as the side walls, there was no motivation in the prior art to lower the height of the columns. Just because, fortuitously, McGrath's end walls may use a handle design that slightly increases their height, this does not create a motivation to lower the column height to be less than the side walls.

**(2) The Cited References Fail To Recognize
The Problem Or Solution Achieved By
The Claimed Invention.**

Appellant's claimed invention advantageously provides interior columns of a height less than the side walls (Group A) or side wall pylons (Group B), wherein Appellant's

smaller interior column height is chosen to measurably reduce the weight of the tray, as well as corresponding mold and cooling times, while still providing sufficient lateral support and stability for bottles loaded in the tray (*see* p. 8, line 20 - p. 9, line 5). The Examiner does not address this issue other than in one brief paragraph on Page 8 of the Examiner's Brief where he states "References may be combined for reasons other than for the problem which the present inventor was concerned with the result being the claimed structure." However, the Examiner cites no "other" reason in the prior art for such a combination. He does suggest that one might combine the references to achieve the saving of weight. This is not mentioned in the references, only in the application. "[T]he teaching or suggestion to make the claimed combination [must] be found in the prior art, **not in applicant's disclosure**." (MPEP 2143); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (emphasis added).

(3) Dependent Claim 32

Claim 32 (Group C) includes language that "the columns have a height of approximately 75% of the height of the pylons," which further qualifies the height difference between the interior columns and the side wall structure. This feature is not disclosed nor suggested by any of the cited references. The Examiner never addresses this limitation. Thus, this claim, which comprises Group C, should be allowed.

**B. Rejection of Claims 1-10, 11-34 and 36
Under 35 U.S.C. § 103(a) Over Apps et al.
'793 or Apps et al '002 In View of Hammett,
et al., McGrath and Sauey.**

The Examiner gives no additional arguments with regard to this alternative rejection. Therefore, Appellant includes no further reply argument as to this rejection, referring the Board to the initial argument and the statements made above as applicable to the secondary references also used in this rejection.

The Examiner's understanding and characterization of the cited references are submitted to be incorrect. The rejections of Claims 1-36 under 35 U.S.C. § 103(a) are in error

for the reasons discussed above and in Appellant's initial brief, it is respectfully requested that these rejections be reversed.

Respectfully submitted,

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